

1614

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**UNITED STATES PATENT AND  
TRADEMARK OFFICE**

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TO: Dorethea Lawrence COMPANY:

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**Applicants:** Szelenyi et al.      **Examiner:** Brian KWON  
**Serial No.:** 10/727,658      **Art Unit:** 1614  
**Filed:** December 5, 2003      **Docket:** 6319-1815 (formerly 034082-001)  
**Title:** Combinations of Potassium Channel Openers and Sodium Channel Inhibitors or  
Sodium Channel -Influencing Active Compounds for Treating Pains

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
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REPLACEMENT TERMINAL DISCLAIMER  
TRANSMITTAL

Sir:

Sir:  
As requested by the Examiner in a telephone call to the undersigned on July 24, 2006, enclosed herewith is a terminal disclaimer that replaces the terminal disclaimer which was filed April 3, 2006, in a response to the Office Action dated November 2, 2005. Applicants respectfully request that the enclosed terminal disclaimer be made of record in this application.

If additional fees are due, Applicants authorize the Commissioner to deduct said fees from deposit account number 02-4270.

**Certificate of Mailing:** I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First-Class Mail addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 4, 2006.

Kimberly Jones

8/4/00

Kimberly Jones  
Printed Name

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TO:Dorethea Lawrence COMPANY:

Respectfully submitted,

Dated: 4 Aug 2006

Heidi Reese  
Heidi Reese  
Reg. No. 57,841  
BROWN RAYSMAN MILLSTEIN FELDER  
& STEINER LLP  
900 Third Avenue  
New York, New York 10022  
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BRMFSI 935512v.1

PAGE 3/5 \* RCVD AT 10/13/2006 3:58:18 PM [Eastern Daylight Time] \* SVR:USPTO-EFXRF-2/9 \* DNIS:2733201 \* CSID:USPTO \* DURATION (mm:ss):02-06

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TO:Dorethea Lawrence COMPANY:



In re Application of: SZELENYI et al.

Application No.: 10727.858

Filed: December 5, 2003

For: VALEANT PHARMACEUTICALS INTERNATIONAL

The owner, VALEANT PHARMACEUTICALS INTERNATIONAL, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending reference Application Number 10727.858 filed on December 5, 2003, as such term is defined in 35 U.S.C. 154 and 173, and as the term of any patent granted on said reference application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending reference application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the reference application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of any patent granted on said reference application, "as the term of any patent granted on said reference application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending reference application," in the event that any such patent, granted on the pending reference application, expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1.  For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2.  The undersigned is an attorney or agent of record. Reg. No. 57,841

*Heidi Reese*

Signature

4 AUGUST 2006

Date

Heidi Reese  
Typed or printed name

212-895-2424  
Telephone Number

- Terminal disclaimer fee under 37 CFR 1.20(d) is included.

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PTO/SB/06 (09-04)

**STATEMENT UNDER 37 CFR 3.73(b)**

Applicant/Patent Owner: Valeant Pharmaceuticals North America (formerly known as Xcel Pharmaceuticals, Inc.)  
Application No./Patent No.: 10/727,658 Filed/Issue Date: December 5, 2003

Entitled: Combinations of potassium channel openers and sodium channel inhibitors or  
sodium channel-influencing active compounds for treating pains

Valeant Pharmaceuticals North America \_\_\_\_\_, a Corporation  
(Name of Assignee)  
(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

- the assignee of the entire right, title, and interest; or
- an assignee of less than the entire right, title and interest.  
The extent (by percentage) of its ownership interest is \_\_\_\_\_ %

In the patent application/patent identified above by virtue of either:

A  An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded  
in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy  
thereof is attached.

OR

B  A chain of title from the inventor(s) of the patent application/patent identified above, to the current assignee as shown  
below:

1. From: Inventor \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at  
Reel 015119, Frame 0604 To: VIATRIS GMBH & CO. KG  
or for which a copy thereof is attached.

2. From: VIATRIS GMBH & CO. KG \_\_\_\_\_ To: XCEL PHARMACEUTICALS, INC.  
The document was recorded in the United States Patent and Trademark Office at  
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3. From: XCEL PHARMACEUTICALS, INC. \_\_\_\_\_ To: VALEANT PHARMACEUTICALS NORTH AMERICA  
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Additional documents in the chain of title are listed on a supplemental sheet.

Copies of assignments or other documents in the chain of title are attached.  
**NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment  
Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See  
MPEP 302.08)**

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

Signature

Printed or Typed Name

Feb. 17 2006  
Date  
017045-0100  
Telephone Number

Robert Choi-Aon

Title

*Assistant Secretary*

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to be (and by law  
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